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D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Interview Summary

On January 26, 2005, Applicants' representative submitted an "Applicant Initiated Interview Request Form" to Examiner Gold via facsimile.

On February 8, 2005 at 11:00 PM EST, an interview was conducted via telephone between Amy Patillo, Applicants' Representative, and Examiner Osman. No exhibits were shown, nor demonstrations conducted.

With regard to the claims, the prior art cited by the Examiner in a 102(e) rejection is Law (US Patent Number 6,690,773).

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed amendment to overcome the 112 rejections. The proposed claim appears in this response. In particular, during the Interview, Applicants requested clarification of whether the "receiving user" is clear in view of the proposed amendment, whether the clarity issues cited by the Examiner regarding claims 16 and 17 are overcome in view of the proposed amendment and whether there is sufficient antecedent basis for the "receiving user" limitation in view of the proposed amendment. The Examiner responded that the proposed amendment seemed to overcome all the previous 112 rejection issues.

In addition, regarding claim 1, Applicants' representative requested clarification of how the Examiner interprets Law to teach "a message entry" and "a plurality of users participating in a messaging session." The Examiner responded that "message" is interpreted broadly to include the mail messages taught in Law because the claim is not specifically limited to "electronic messages." In addition, the Examiner responded that "a plurality of users participating in a messaging session" is interpreted broadly to include "multiple users sending mail."

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Regarding claim 3, Applicants' representative requested clarification how what specific teaching in col. 4 lines 20-65 and 54-65 of Law as cited by the Examiner teach the element of "channel options for messaging session." The Examiner responded that the teachings of "user profiles" and "specifying a preferred mode of communication" teach the element of "channel options for messaging session."

Regarding claims 4, 5, 6, and 7, Applicants' representative requested clarification of what specific teaching in col. 4, lines 54-65 of Law the Examiner cites for the elements of "assigning a distinguishable graphic, distinguishable font, particular graphical window display, or particular sound." Applicants' representative noted that Law does not teach a graphical, font, window display, or sound preferences. The Examiner responded that these elements are broadly interpreted as taught by the delivery preferences taught by Law.

Regarding claim 33, Applicants' representative requested clarification of how Law or portions of Law cited by the Examiner in the Abstract, col. 1, lines 53-65, and col. 5, lines 8-15 teach the elements of "receiving a request of a new topic", "a particular channel of a messaging session", and "updating a plurality of topic options for said particular channel of said messaging session to said plurality of users participating in said particular channel, such that said new topic is selectable by said plurality of users in association with a message entry." Applicants' representative argued, in particular, that Law does not teach "receiving a request of a new topic". The Examiner responded that because the messages are not specified as "electronic" that the claims are broadly interpreted to include the mail messages generated in Law. The Examiner agreed with Applicants' representative, however, that Law does not teach "receiving a request of a new topic."

In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

Claim Objections

The Examiner notes claims 37-40 depend on claim 1 and should not be separated from claim 1 by claims 12-36. Applicants amend claims 37-40 so that each of these dependent claims

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is dependent upon independent claim 36, and not on independent claim 1. Applicants respectfully request that the objection be removed and the claims 37-40 allowed.

35 USC § 112

The Examiner rejected claims 1, 12, and 23 under 35 USC 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention. [Office Action, p. 2]

First, in particular, the Examiner asserts that line 10 of claim 1 is unclear and should be rewritten to a variation of “sending user who is from among a plurality of users.” [Office Action, p. 3] To clarify the claim, Applicants amend claims 1, 12, and 23 to now read “a sending user who is from among a plurality of users.”

Second, the Examiner asserts that in line 14 of claim 1, the element of “for each separate receiving user” is unclear and should be rewritten to a variation of “for each separate sending user”, to maintain consistency within the claim. [Office Action, p. 3] Applicants respectfully disagree with the Examiner’s suggested adjustment of “sending user” to “receiving user”. Applicants do, however, amend claim 1 to clarify the “receiving user” element by adding “wherein at least one receiving user from among said plurality of users participating in said messaging session is intended to receive said electronic message entry” and deleting “separate” to distinguish a “receiving user” from a “sending user”.

Third, the Examiner asserts that lines 16 and 17 of claim 1 are “unclear language and should be rewritten to particularly point out what applicant means.” [Office Action, p. 3] Applicants requested clarification of the specific language that was unclear during the interview. The Examiner clarified that the carryover of amendments to overcome the clarity issues in lines 10 and 14 would clarify the language in lines 16 and 17.

In addition, the Examiner asserts that claims 1, 12, and 23 receive the limitation “receiving user” in page 1 line 14” and “that there is insufficient antecedent basis for this limitation in the claim”. [Office Action, p. 3] Applicants requested clarification of this rejection during the interview. The Examiner requested that the element of “receiving user” include an

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“a” or “a plurality of”, to have proper antecedent basis. Applicants amend claims 1, 12, and 23 so that the first use of “receiving user” is “at least one receiving user.”

In conclusion, Applicants have amended claims 1, 12, and 23 to overcome the 112 rejections of the Examiner. Therefore, Applicants respectfully request removal of the 112 rejection and allowance of the claims.

35 USC § 102(e)

Claims 1-59

Claims 1-59 stand rejected under 35 U.S.C. §102(e) as being anticipated by Law (US Patent Number 6,690,773). The rejection is respectfully traversed. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Law teaches each and every element of the claims 1-59 or enables each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

Claims 1, 12, and 23

Independent method claim 1, which is representative of independent system claim 12 and independent computer program product claim 23, with regard to similarly recited subject matter and rejection, reads as follows:

1. (Currently Amended) A method for specifying messaging session outputs, comprising the steps of:

receiving a message entry associated with a particular topic from among a plurality of available topics from a [separate] sending user who is from among a plurality of users participating in a messaging session, wherein said sending user inserts said message entry in said messaging session in association with said particular topic, wherein at least one receiving user from among said plurality of

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users participating in said messaging session is intended to receive said message entry, wherein said messaging session facilitates network based communication via an instant messaging channel between said plurality of users; and

assigning a separate output attribute [attributes] to said message entry for each [separate] said receiving user [from among said plurality of users], wherein each said separate output attribute is assigned according to a plurality of receiving user specified output preferences for said particular topic, wherein each of said plurality of receiving user specified output preferences is associated with one from among each said [separate] receiving user [participating in said messaging session], such that output of said message entry is uniquely specified for [received by] each said [separate] receiving user.

Applicants respectfully assert that Law does not teach, expressly or inherently, or enable the invention of amended claims 1, 12, and 23 because Law does not teach or enable receiving a message entry associated with a particular topic from among a plurality of available topics from a sending user who is from among a plurality of users participating in a messaging session, wherein said sending user inserts said message entry in said messaging session in association with said particular topic, wherein at least one receiving user from among said plurality of users participating in said messaging session is intended to receive said message entry, wherein said messaging session facilitates network based communication via an instant messaging channel between said plurality of users or assigning a separate output attribute to said message entry for each said receiving user, wherein each said separate output attribute is assigned according to a plurality of receiving user specified output preferences for said particular topic, wherein each of said plurality of receiving user specified output preferences is associated with one from among each said receiving user, such that output of said message entry is uniquely specified for each said receiving user. Because Law does not teach or enable the invention of amended claims 1, 12, and 23, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

In particular, with respect to claims 1, 12, and 23, the Examiner cites the Abstract, the Summary of the Invention, and col. 6, lines 30-65 as teaching the elements of claims 1, 12, and 23. Law teaches a system for improving "recipient control over various parameters associated

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with messages, in particular mail, intended for a recipient.” (Law, col. 2, lines 19-23). The

Abstract of Law teaches:

“An information system includes a plurality of messaging systems, a data center, and a control system. The plurality of messaging systems process respective messages intended for recipients. The data center is in operative communication with the plurality of messaging systems and stores a recipient preference profile associated with each respective recipient. The control system accessing an intended recipient preference profile corresponding to an intended recipient of a message and uses the intended recipient preference profile to process the message.”

Lines 26 through 42 of the summary in Law read:

“The present invention provides a system and method for improving the collection and dissemination of recipient preferences for messages. Generally, this is accomplished by collecting recipient preference data and making it available to a plurality of discrete messaging systems for use in preparing messages intended for a selected recipient.

In accordance with the present invention, there is provided a system including a plurality of messaging systems, a data center, and a control system. The plurality of messaging systems process respective messages intended for recipients. The data center is in operative communication with the plurality of messaging systems and stores a recipient preference profile associated with each respective recipient. The control system accessing an intended recipient preference profile corresponding to an intended recipient of a message and uses the intended recipient preference profile to process the message.”

Col. 6, lines 33-65 of Law read:

“The interest data 190d and the no interest data 190e may also be established by the recipients 180 and utilized by the messaging systems 150 to more effectively route messages to the intended recipient 180. Using the interest data 190d, the senders may scan the profiles 190 looking for recipients that are likely to be interested in their messages (solicitations, informational communication, etc.). Thus, the senders would achieve greater effectiveness on their message delivery programs because they would have an indication the certain recipients 180 have a previously acknowledged interest in a particular industry or industries. On the other hand, using the no interest data 190e, the senders may also increase the effectiveness of their message delivery programs while reducing costs. While scanning the profiles 190 in general or accessing profiles 190 for recipients 180 that have already be designated to receive a message, the sender may terminate further processing of certain messages by out sorting any recipients 180 that have provided an indication that they are not likely

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to be interested in any messages (solicitations, information communication, etc. from a particular industry or industries. In other words, messages intended for such recipients will be terminated (not generated, not dispatched, etc.). This may be achieved automatically by including in the messaging systems 150 an indication of the senders SIC number. Thus, the SIC numbers supplied by the recipients as no interest data may be compared with the SIC numbers assigned to the senders. Thus, the senders would save costs by foregoing to dispatch any messages to these recipients 180. Additionally, these recipients 180 benefit in that they are not distracted by the recipient of undesired messages.”

First, Law does not teach or enable receiving a message entry associated with a particular topic from among a plurality of available topics from a sending user who is from among a plurality of users participating in a messaging session... wherein said messaging session facilitates network based communication via an instant messaging channel between said plurality of users. Law teaches enabling a business to submit a message to a messaging system, where the messaging system then accesses intended recipient preferences from a centralized data center and adjusts a message for output to a particular intended recipient according to the intended recipient preferences (Law, col. 3, line 17 through col. 4, line 34). Law does not teach receiving a message entry as part of a messaging session via an instant messaging channel between multiple users. Further, Law focuses on messaging systems that print postal mail and not messaging systems that facilitate network based communications via an instant messaging channel (Law, col. 3, lines 29-40). In contrast, the present invention teaches a messaging system that receiving a messaging entry within a messaging session participated in by multiple users, where the messaging session facilitates network based communication via an instant messaging channel between multiple users.

Second, Law does not teach or enable assigning a separate output attribute to said message entry for each said receiving user, wherein each said separate output attribute is assigned according to a plurality of receiving user specified output preferences for said particular topic, wherein each of said plurality of receiving user specified output preferences is associated with one from among each said receiving user, such that output of said message entry is uniquely specified for each said receiving user. As previously asserted, Law does not teach receiving a message entry within a messaging session, where a messaging session facilitates network based

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communication via an instant messaging channel between multiple users. In addition, Law does not teach or enable assigning separate output attributes to message entries for each receiving user as part of a messaging session, where the message session facilitates real time network based communication between multiple users. In contrast, the present invention teaches assigning a separate output attribute to a message entry for each recipient according to each recipient's output preferences for output within the real time network based communication messaging session.

Therefore, Applicants respectfully assert that because Law does not teach or enable messaging systems that support separate output attributes for message entries entered as part of a network based communication via an instant messaging channel between multiple users, Law does not teach at least one element of claims 1, 12, and 23. Because Law does not teach, expressly or inherently, or enable at least one element of claims 1, 12, and 23, Law does not anticipate claims 1, 12, and 23 and the claims should be allowed.

In addition, Applicants note that claims 1, 12, and 23 have been amended for purposes of clarification to overcome the 112 rejection, as previously described, and to clarify the scope of a messaging session. Applicants assert that the amendments to clarify the scope of a messaging session are fully supported in the specification of the present invention. In particular, page 11, lines 5-10 of the specification generally describe a messaging session follows:

“A “messaging session” preferably includes, but is not limited to, any combination of voice and/or text messages, instant and/or delayed, transmitted between multiple users via a network. Messaging sessions may include use of chat rooms, instant messages, e-mail, conference calling and other network methods of providing a channel for users to communicate within.”

Applicants amend claims 1, 12, and 23 to clarify that the scope of the claimed invention includes instant communication based messaging systems.

Claims 2-11, 13-22, and 24-32

Because Law does not anticipate claims 1, 12, and 23, at least by virtue of their dependency on claims 1, 12, and 23, Law does not teach or enable the features of dependent claims 2-11, 13-22, and 24-32 under 35 U.S.C. §102 (e). Because anticipation is not established

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for claims 2-11, 13-22, and 24-32, Applicants respectfully request allowance of claims 2-11, 13-22, and 24-32.

In particular, with regard to claims 3, 14 and 24, the Examiner cites col. 4, lines 20-65 and 54-65 as teaching assigning output attributes to said message entry according to channel options for said messaging session. Col. 4, lines 20-65 and 54-65 teach the types of preferences that a recipient may set in a profile. Col. 4, lines 20-65 and 54-65 do not teach, nor does not Examiner specify how Law teaches, channel options for a messaging session. Further, as amended, claims 1 and 12 clarify that a messaging session facilitates network based communication via an instant messaging channel, which is not taught or enabled by Law. In contrast, claims 3 and 14 teach assigning output attributes to message entries according to the options of the instant messaging channel, such that the output options available for the channel may limit the output attributes that may be assigned to message entries. Because Law does not teach channel option based output assignment, Applicants respectfully request allowance of claims 3 and 14.

In addition, with regard to claims 4, 5, 6, 7, 15, 16, 17, 18, 19, 25, 26, 27, and 28, the Examiner cites col. 4, lines 54-65 of Law as teaching assigning a graphic, a distinguishable font, a particular graphical window display, and a particular sound to said message entry. Applicants first note that during the Interview, the Examiner stated that these elements of a distinguishable graphic, a distinguishable font, a particular graphical window display, and a particular sound are not specifically taught by Law, but are included as delivery preferences, which are taught by Law. The delivery preferences taught by Law, however, include examples such as "hold messages, temporary reroute messages, etc." Holding or rerouting a message does not inherently teach that a delivery preference includes assigning an output attribute that affects the way that a message entry looks or sounds on output. In contrast, the present invention teaches assigning output attributes that may include a distinguishable graphic, a distinguishable font, a particular graphical window display, or a particular sound. Because Law does not teach, expressly or inherently, the elements of claims 4, 5, 6, 7, 15, 16, 17, 18, 19, 25, 26, 27, and 28, Applicants respectfully request allowance of these claims.

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Applicants also note that claims 2-11, 14-22, and 24 are amended responsive to the amendments to claim 1, 12, and 23, to maintain proper antecedent basis.

Claims 33-35

Independent method claim 33, which is representative of independent system claim 34 and independent computer program product claim 35, with regard to similarly recited subject matter and rejection, reads as follows:

33.(Original) A method for organizing messaging sessions, said method comprising the steps of:

receiving a request for a new topic from a particular user from among a plurality of users participating in a particular channel of a messaging session; and
in response to approving said new topic, updating a plurality of topic options for said particular channel of said messaging session to said plurality of users participating in said particular channel, such that said new topic is selectable by said plurality of users in association with a message entry.

Applicants respectfully assert that Law does not teach, expressly or inherently, or enable the invention of claims 33-35 because Law does not teach or enable receiving a request for a new topic from a particular user from among a plurality of users participating in a particular channel of a messaging session or updating a plurality of topic options for said particular channel of said messaging session to said plurality of users participating in said particular channel, such that said new topic is selectable by said plurality of users in association with a message entry, in response to approving said new topic. Because Law does not teach or enable at least one element of claims, Applicants respectfully request withdrawal of the rejection and allowance of claims 33-35.

The Examiner cites the summary of Law as teaching receiving a request for a new topic from a particular user from among a plurality of users participating in a particular channel of a messaging session. The summary of Law, in col. 2, lines 26 through 42, as previously cited, describes a system where recipients can update a profile at a central location and multiple messaging systems may access the profile to adjust the addressing, delivery, and other variables of mail delivery. Law does not teach, as was acknowledged by the Examiner in the interview, the element of receiving a request for a new topic. In addition, Applicants note, as previously

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asserted, that Law does not facilitate multiple users participating in a messaging session via a channel. Therefore, because Law does not teach at least the element of receiving a request for a new topic and furthermore does not teach receiving a request for a new topic from a particular user from among a plurality of users participating in a particular channel of a messaging session, Applicants respectfully assert that Law does not anticipate claims 33-35 and the claims should be allowed.

In addition, the Examiner cites col. 1, lines 53-65 and col. 5, lines 8-15 as teaching updating a plurality of topic options for said particular channel of said messaging session to said plurality of users participating in said particular channel, such that said new topic is selectable by said plurality of users in association with a message entry, in response to approving said new topic. Col. 1, lines 53-65 and col. 5, lines 8-15 teach that current address correction systems are limited, but that Law's system enables a recipient to update a single profile for address correction. Law makes no mention of updating topic options for a particular channel of a messaging session. Furthermore, a system in which a user can update the user's address does not inherently teach a system where a user may request a new topic for a messaging session channel and that the messaging system will then update the topic options for that channel if the new topic request is approved. In contrast, the present invention teaches updating topic options for a channel of a messaging session to the users participating in the channel, where the other users may then select the new topic in association with a message entry, responsive to approval of the new topic. Therefore, because Law does not teach, expressly or inherently, at least the element of updating topic options for a particular channel of a messaging session, Applicants respectfully assert that Law does not anticipate claims 33-35 and the claims should be allowed.

Claims 36, 41, and 46

Independent system claim 41 (cited by the Examiner for the rejection), which is representative of independent method claim 36 and independent computer program product claim 46, with regard to similarly recited subject matter and rejection, reads as follows:

41.(Currently Amended) A system for controlling messaging outputs in a messaging session, said system comprising:

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a client messaging system communicatively connected to a network;
said client messaging system further comprising:
means for receiving a plurality of message entries intended for a particular recipient and each associated with a particular topic from among a plurality of topics within a particular channel of [a] an instant messaging session messaging session; and
means for controlling output of said plurality of message entries according to output attributes assigned to said plurality of message entries for [a] said particular [user] recipient to distinguish [according to a receiving user's preferences] between said plurality of topics according to preferences of said particular recipient, such that output of said plurality of message entries according to topic is distinguished according to [a user] said particular recipient receiving said plurality of message entries.

Applicants respectfully assert that Law does not teach, expressly or inherently, or enable the invention of claims 36, 41, and 46 because Law does not teach or enable a client messaging system or a client messaging system with means for receiving a plurality of message entries each associated with a particular topic from among a plurality of topics within a particular channel of an instant messaging session. Because Law does not teach or enable at least one element of claims 36, 41, and 46, Applicants respectfully request withdrawal of the rejection and allowance of claims 36, 41, and 46.

The Examiner cites col. 3, lines 20-67 as teaching a client messaging system communicatively connected to a network. Col. 3, lines 20-67 describe the scope of "messaging systems" in Law. In particular, col. 3, lines 25 through 27 read: "The messaging systems 150 may include any device that is utilized by a sender (not shown) to produce a message (not shown) intended for a recipient 180." Thus, Law describes the messaging system as one that is used by the sender, not the recipient. Law does not describe a client messaging system, where client implies the recipient of a message or service, not the sender of the message or service. In contrast, the present invention teaches a client system communicatively connected to a network, where the client messaging system comprises means for controlling output of message entries, not filtering or distribution of message entries.

In addition, the Examiner cites the Abstract of Law as teaching receiving a plurality of message entries each associated with a particular topic from among a plurality of topics within a

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particular channel of an instant messaging session. As previously cited, the Abstract of Law reads:

“An information system includes a plurality of messaging systems, a data center, and a control system. The plurality of messaging systems process respective messages intended for recipients. The data center is in operative communication with the plurality of messaging systems and stores a recipient preference profile associated with each respective recipient. The control system accessing an intended recipient preference profile corresponding to an intended recipient of a message and uses the intended recipient preference profile to process the message.”

The abstract of Law does not teach, expressly or inherently, receiving messaging entries associated with a particular topic. In addition, the Abstract of Law does not teach, expressly or inherently, receiving message entries within a particular channel of an instant messaging session. Further, a messaging system does not inherently teach a channel based messaging session through which multiple users may communicate with one another in real time. Law describes the messaging systems, in col. 3, lines 20-67, as printers, postage systems, and potentially electronic mail systems, but does not enable a messaging system with means for receiving multiple message entries within a particular channel of an instant messaging session. In contrast, the present invention teaches receiving multiple message entries, each associated with a particular topic, within a particular channel of an instant messaging session. Because Law does not teach or enable a messaging system with means for receiving message entries within a particular channel of an instant messaging session, Law does not anticipate claims 36, 41, and 46 and the claims should be allowed.

Applicants note that claims 36, 41, and 46 are amended to clarify the scope of the term “messaging session” to include an “instant messaging session”, which is supported in the specification of the invention on page 11, lines 5-10, as previously described with reference to claims 1, 12, and 23. In addition, Applicants note that claims 36, 41, and 46 are amended to clarify that output of message entries is distinguished for each recipient.

Claims 37-40, 42-45, and 47-50

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Because Law does not anticipate claims 36, 41, and 46, at least by virtue of their dependency on claims 36, 41, and 46, Law does not teach or enable the features of dependent claims 37-40, 42-45, and 47-50 under 35 U.S.C. §102 (e). Because anticipation is not established for claims 37-40, 42-45, and 47-50, Applicants respectfully request allowance of claims 37-40, 42-45, and 47-50.

In addition, with regard to claims 38-40, 43-45, and 48-50, the Examiner cites col. 4, lines 54-65 of Law as teaching means for controlling output of said plurality of message entries according to an assigned audible output attribute, to distinguish between said plurality of users, or in a distinguishable graphical interface according to said plurality of topics. Applicants first note that during the Interview, with regard to dependent claims 5-8, which are related in subject matter to claims 38-40, 43-45, and 48-50 and rejected on the same grounds and paragraphs, the Examiner stated that the elements of a distinguishable graphic, a distinguishable font, a particular graphical window display, and a particular sound are not specifically taught by Law, but are included as delivery preferences, which are taught by Law. The delivery preferences taught by Law, however, include examples such as “hold messages, temporary reroute messages, etc.” Holding or rerouting a message does not inherently teach that a delivery preference includes assigning an output attribute that affects the way that a message entry looks or sounds on output. With respect to claims 38-40, 43-45, and 48-50, Law also does not teach controlling output according to an assigned audible output attribute, in a distinguishable graphical interface or to distinguish between users. In contrast, the present invention does teach controlling output of message entries according to assigned audible output attributes, to distinguish between users, and in a distinguishable graphical interface according to topic. Because Law does not teach, expressly or inherently, the elements of claims 38-40, 43-45, and 48-50, Applicants respectfully request allowance of these claims.

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Claims 51, 53, and 55

Independent method claim 51, which is representative of independent system claim 53 and independent computer program product claim 55, with regard to similarly recited subject matter and rejection, reads as follows:

51. (Original) A method for enabling topic selection within a messaging system, said method comprising the steps of:
displaying a plurality of selectable topics available for selection in association with a message entry prior to distribution;
receiving a selection from among said plurality of selectable topic by a sending user participating in a messaging session; and
assigning a particular topic associated with said selection from among said plurality of selectable topics to a message entry prior to distribution of said message entry to at least one other user participating in said messaging session.

Applicants respectfully assert that Law does not teach, expressly or inherently, or enable the invention of claims 51, 53, and 55 because Law does not teach or enable displaying a plurality of selectable topics available for selection in association with a message entry prior to distribution, receiving a selection from among said plurality of selectable topic by a sending user participating in a messaging session, or assigning a particular topic associated with said selection from among said plurality of selectable topics to a message entry prior to distribution of said message entry to at least one other user participating in said messaging session. Because Law does not teach or enable any of the elements of claims 51, 53, and 55, Applicants respectfully request withdrawal of the rejection and allowance of claims 51, 53, and 55.

The Examiner cites the summary of Law and col. 6, lines 30-65 of Law as teaching the elements of claims 51, 53, and 55. The text of the summary and of col. 6, lines 30-65 are cited above.

First, Law does not teach displaying a plurality of selectable topics available for selection in association with a message entry prior to distribution because Law does not teach displaying selectable topics. Col. 6, lines 30-65, describes a determination of whether a recipient would be interested or not interested in a particular message by automatically scanning the “interest data 190d” and the “no interest data” 190e included in a recipient profile for information that would

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help determine a recipient's interest. Nothing in Col. 6, lines 30-65 of Law, the summary of Law, or any other part of Law teaches, expressly or inherently, displaying selectable topics. Further, Law does not teach displaying selectable topics for selection in association with a message entry. In contrast, the present invention teaches displaying multiple selectable topics available for selection in association with a message entry prior to distribution. Therefore, because Law does not teach at least the element of displaying a plurality of selectable topics, Law does not anticipate claims 51, 53, and 55 and the claims should be allowed.

Second, Law does not teach receiving a selection from among said plurality of selectable topic by a sending user participating in a messaging session or assigning a particular topic associated with said selection from among said plurality of selectable topics to a message entry prior to distribution of said message entry to at least one other user participating in said messaging session because Law does not teach receiving a topic selection or assigning a topic selection of a message entry. Col. 6, lines 30-65 of Law teaches that senders may scan profiles looking for potential interested recipients of a message. Col. 6, lines 30-65 of Law does not teach receiving a selection of a topic by a sender. Law also does not teach assigning the selected topic to a message entry prior to distribution of the message entry to other users participating in the messaging session. In contrast, the present invention teaches receiving a selection of a particular topic by a sender participating in a messaging session and assigning the selected topic to a message entry prior to distribution. Therefore, because Law does not teach at least the element of receiving a selection from among said plurality of selectable topics, Law does not anticipate claims 51, 53, and 55 and the claims should be allowed.

Claims 52, 54, and 56

Because Law does not anticipate claims 51, 53, or 55, at least by virtue of their dependency on claims 51, 53, and 55, Law does not teach or enable the features of dependent claims 52, 54, and 56 under 35 U.S.C. §102 (e). Because anticipation is not established for claims 52, 54, and 56, Applicants respectfully request allowance of claims 52, 54, and 56.

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In addition, in particular, claim 52, which is representative of dependent system claim 54 and dependent computer program product claim 56, with regard to similarly recited subject matter and rejection, reads as follows:

52.(Original) The method for enabling topic selection within a messaging system according to claim 51, said method further comprising the step of:

displaying said plurality of selectable topics each with a separate graphical attribute also utilized to distinguishably display a selection of message entries received with assignments to each of said plurality of selectable topics.

The Examiner cites col. 6, lines 30-65 as teaching displaying said plurality of selectable topics each with a separate graphical attribute also utilized to distinguishably display a selection of message entries received with assignments to each of said plurality of selectable topics. Col. 6, lines 30-65, describes a determination of whether a recipient would be interested or not interested in a particular message by scanning the “interest data 190d” and the “no interest data” 190e included in a recipient profile. Nothing in Col. 6, lines 30-65 of Law or any other part of Law teaches, expressly or inherently, displaying selectable topics. Further, Law does not teach displaying selectable topics with separate graphical attributes that also mark each message entry to indicate the topic that the message entries is associated with. In contrast, the present invention teaches displaying selectable topics which are each identified by a graphical attribute used to distinguishably displayed those message entries assigned to each topic. Therefore, because Law does not teach at least the element of displaying said plurality of selectable topics each with a separate graphical attribute, Law does not anticipate claims 52, 54, and 56 and the claims should be allowed.

Claims 57-59

Independent method claim 57, which is representative of independent system claim 58 and independent computer program product claim 59, with regard to similarly recited subject matter and rejection, reads as follows:

57. (Currently Amended) A method for specializing outputs in a messaging system, said method comprising the steps of:

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enabling selection of output preferences for output of received message entries within [a] an instant messaging session according to at least [any] one of a topic, a user, and a device; and
distinguishing said output of said received message entries according to said output preferences by utilizing a [unique] distinguishable variation in at least [any] one of a color, a font, a style, [or] and an audible output [audio].

Applicants respectfully assert that Law does not teach, expressly or inherently, or enable the invention of claims 57-59 because Law does not teach or enable enabling selection of output preferences for output of received message entries within an instant messaging session or according to at least one of a topic, a user, and a device. Because Law does not teach or enable any of the elements of claims 57-59, Applicants respectfully request withdrawal of the rejection and allowance of claims 57-59.

In particular, the Examiner cites the summary and col. 6, lines 30-65 as teaching enabling selection of output preferences for output of received message entries within an instant messaging session or according to at least one of a topic, a user, and a device. Applicants note that Law does not teach or enable an instant messaging session, as previously asserted in regard to claims 1, 12, and 23. Therefore, Law also does not teach or enable selection of output preferences for output of received message entries within an instant messaging session. Because Law does not teach at least the element of enabling selection of output preferences for output of received message entries within an instant messaging session, Law does not anticipate claims 57-59 and the claims should be allowed.

Applicants note that claims 57-59 are amended to clarify the scope of the term “messaging session” to include an “instant messaging session”, which is supported in the specification of the invention on page 11, lines 5-10, as previously described with reference to claims 1, 12, and 23. In addition, Applicants amend claims 57-59 to clarify that “at least one” is selected, rather than just “any one of” a topic, user and device or color, font, style, and audible output.

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

 on 2/17/2005

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